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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,224	10/16/2001	Reuben Bahar	133/117	4472

7590 02/03/2009
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EXAMINER

BILGRAMI, ASGHAR H

ART UNIT	PAPER NUMBER
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2443

MAIL DATE	DELIVERY MODE
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02/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/978,224	BAHAR, REUBEN	
	Examiner	Art Unit	
	ASGHAR BILGRAMI	2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 184-189, 191-213, 215-229, 231-234, 236-243, 248-255, 258-271, 279, 327-340 and 346-348 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 184-189,191-213,215-229,231-234,236-243,248-255,258-271,279,327-340 and 346-348.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Amended claim 248 is rejected under 35 U.S.C 101 because the software is not embodied on “computer storage medium” making the claim non-statutory. Appropriate correction is required.

3. Dependent claims 249-251 & 346 are also rejected under 35 U.S.C 101 by virtue of their dependent on claim 248.

4. Amended claim 252 is also rejected under 35 U.S.C 101 because the software is not embodied on “computer storage medium” making the claim non-statutory.

Appropriate correction is required.

5. Dependent claims 253-255, 279, 347 & 348 are also rejected under 35 U.S.C 101 by virtue of their dependent on claim 252.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 236 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Line 3 of claim 236 states "receiving an e-mail into a recipient e-mail address". The claim language is indefinite and un-clear as to how an email can be received into an e-mail address. For examine purposes examiner has assumed the above claim language as "receiving an e-mail at a recipient e-mail address".

Appropriate correction is required to clarify the indented meaning.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 184-189, 191-213, 215-229, 231-234, 236-243, 248-255, 258-271, 279, 327-340, 346-348 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (U.S. 6,629,131B1), Flynn et al (U.S. 6,618,747B1) and Kanevsky et al (U.S. 6,836,846).

10. As per claims 236, 248, 260, 252, 258, 264, 268 Choi disclosed a method for verifying whether an e-mail received by a recipient was accessed by an intended recipient, said method comprising: a) receiving an e-mail at a recipient e-mail address (col.2, lines 59-67). However Choi did not explicitly disclose b) detecting an access event, and prompting the party associated with said event to input recipient data prior to

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allowing the requested access (c) biometric identification means for recognizing biometric attributes of an individual (d) acquiring recipient data that is related to biometric identification of the recipient (e) permitting said e-mail to be accessed after the party associated with the said access event inputs said recipient data (f) means for sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail.

In the same field of endeavor Kanevsky et al disclosed b) detecting an access event, and prompting the party associated with said event to input recipient data prior to allowing the requested access (col.6, lines 1-26) (c) biometric identification means for recognizing biometric attributes of an individual (d) acquiring recipient data that is related to biometric identification of the recipient (col.4, lines 62-67, col.5, lines 1-15 & col.5, lines 46-67) (e) permitting said e-mail to be accessed after the party associated with the said access event inputs said recipient data (col.7, lines 7-10).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated detecting an accessing individual through utilization of biometric attributes as disclosed by Kanevsky in a method of verifying whether e-mail was delivered to the intended recipient as disclosed by Choi in order to enhance the security of the e-mail delivery system resulting in secure and protected reception of the e-mail by only the intended actual recipient.

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Both Choi and Kavensky did not explicitly disclose, (f) sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail.

In the same field of endeavor Flynn disclosed (f) sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail. (col.6, lines 53-56).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail as disclosed by Flynn in a method of verifying whether e-mail was delivered to the intended recipient as disclosed by Choi and Kanevsky in order to make the e-mail delivery system more secure and protected by giving the sender the ability to know exactly whether the e-mail content was delivered to the recipient resulting in assured and verified communication between users on a network.

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11. As per claims 185,191, 208-210, 215, 249-251, 253-255, 259, 261-263, 265-267, 269-271, 279, 327, 329, 335, 336, 338 & 346-348 Choi-Flynn-Kanevsky disclosed the method as recited in claim 258 wherein said step of recipient data for confirming proper delivery of said e-mail includes the steps of: (a) generating a confirmation of receipt notice wherein the inputted recipient data is included with said confirmation receipt notice; and (b) sending said confirmation of receipt notice, wherein the inputted receipt data included with said confirmation of receipt can be compared to information associated with said intended recipient in order to verify whether the e-mail was accessed by the intended recipient (Flynn, col.6, lines 66-67 & col.7, lines 1-21).

12. As per claims 212 Choi-Flynn-Kanevsky disclosed the method as in claim 260, wherein the step of transmitting an e-mail from a sender computer includes attaching an executable attachment file in conjunction with the e-mail, the executable attachment file having a first module for discovering the stored recipient data file that is associated with actual recipient e-mail address and wherein the step of detecting an access event includes the step of executing the first module of the executable attachment file (Flynn col.53-67 & col.7. lines 1-19).

13. As per claims 213 Choi-Flynn-Kanevsky disclosed the method as in claim 212, wherein the executable attachment file has a fourth module transmitted and delivered therewith, the fourth module for detecting the access event, and further comprising the

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step of automatically executing the fourth module upon delivery of the attachment file to the recipient e-mail address (Flynn col.53-67 & col.7. lines 1-19).

14. As per claims 216 Choi-Flynn-Kanevsky disclosed the method as in claim 215, wherein said recipient computer is a server of a service provider that is capable of receiving e-mail (Choi, col.2, lines 59-67).

15. As per claim 233 Choi-Flynn-Kanevsky disclosed the method as in claim 260, wherein said recipient data is acquired as a requisite condition for operating a remote user computer, said remote user computer being operable to gain access to said recipient e-mail address (Flynn, col.5, lines 46-67 & col.6, lines 1-21).

16. As per claims 218, 198, 196, 200, 234, 238, 239, 240, 241, 195, 219, 222, 243, 199, 221, 242, 197, 203, 225, 204, 226, 205, 227, 201, 223, 193, 217, 187, 211, 330, 331, 334, 337, 339 & 340 Choi-Flynn-Kanevsky disclosed the method as in claim 155, wherein said acquired recipient data is related to alphanumeric text identification, biometric identification, password identification, a computer generated user code, or a combination thereof (Bisbee, col.1, lines 37-51 & col.4, lines 36-67).

17. As per claims 202 & 224 Choi-Flynn-Kanevsky disclosed the method as in claim 236 further including the step of sending access event data of attendant conditions of said access event (Flynn col.6, lines 53-67 & col.7. lines 1-19).

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18. As per claims 206, 207, 228 & 229 Choi-Flynn-Kanevsky disclosed the method as in claim 236, wherein said step of identifying data is used to verify proper delivery of legal documents, confidential documents (Flynn, col.5, lines 46-67 & col.6, lines 1-21).

19. As per claim 332 Choi-Kanvesky-Flynn disclosed the method as in claim 258 wherein said recipient data for confirming proper delivery of said e-mail is sent to an e-mail address(Choi, col.2, lines 60-67 & col.3, lines 1-9).

20. As per claim 334 Choi-Kanvesky-Flynn disclosed the method as in claim 258, wherein said inputted recipient data pertains to alphanumeric text identification, biometric identification, password identification, a computer generated user code, or a combination thereof (Kanevsky, col.4, lines 62-67, col.5, lines 1-15 & col.5, lines 46-67).

21. As per claim 184 Choi-Kanvesky-Flynn disclosed the method as recited in claim 258 wherein said step of sending recipient data for confirming proper delivery of said E-mail includes the steps of: a) generating a confirmation of receipt notice wherein the inputted recipient data is included with said confirmation of receipt notice; and b) sending said confirmation of receipt notice, wherein the inputted recipient data included with said confirmation of receipt notice can be compared to information associated with said intended recipient in order to verify whether the e-mail was accessed by the intended recipient (Choi, col.2, lines 60-67 & col.3, lines 1-9).

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22. As per claim 333 Choi-Kanvesky-Flynn disclosed the method as in claims 184, wherein said confirmation of receipt notice is sent to an e-mail address (Choi, col.2, lines 60-67 & col.3, lines 1-30).

Response to Arguments

23. Applicant's arguments with respect to claims 184-189, 191-213, 215-229, 231-234, 236-243, 248-255, 258-271, 279, 327-340, 346-348 have been fully considered but are not persuasive.

24. Applicant argued that in the last office action neither claims 236 & 248 recite the use of biometric but they were rejected with claims 252, 260, 264 and 268.

As to applicant's argument in the previous office action claims 236 & 248 disclosed recipient identifying data (I.E. password etc) and claims 252, 260, 264 and 268 disclose recipient identifying data to be "biometric attributes" (finger print, retina scan etc).

Examiner combined all the limitations of claims 236, 248 and the biometric limitation of claims 252, 260, 264 and 268 in a single claim due to similarity in claim language and addressed them with the appropriate prior arts to make the rejection. Now since applicant has amended the limitations of all the independent claims they are addressed appropriately on in this office action.

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25. With respect to claims 236 applicant argued that the current amendments overcome the prior art.

As to applicant's argument in light of the current amendments to claim 248 examiner has revised the rejection and cited pertinent portions for the previously applied prior art that anticipate the newly amended claim language.

26. Applicant with respect to claim 248 argued that newly amended claims overcome the prior art.

As to applicant's argument in light of the current amendments to independent claim 248 examiner has revised the rejection and cited pertinent portions for the previously applied prior art that anticipate the newly amended claim language.

27. As to claim 252 applicant argued that the prior art fails to disclose the amended claim.

As to applicant's argument in light of the current amendments to independent claim 252 examiner has revised the rejection and cited pertinent portions for the previously applied prior art that anticipate the newly amended claim language.

28. Applicant on page 24 argued that there is no motivation to combine the Choi-Kanvesky-Flynn to anticipate applicant's invention.

As to applicant's argument all three prior arts Choi-Kanvesky and Flynn disclose the dissemination of electronic mail from a sender to receiver in a computer network environment therefore it is appropriate to combine all three prior arts to anticipate applicant's invention.

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29. Applicant with respect to amended claims 260, 264 & 268 argued that the prior art failed to disclose the amended claim.

As to applicant's argument in light of the current amendments to independent claims 260, 264 & 268 examiner has revised the rejection and cited pertinent portions for the previously applied prior art that anticipate the newly amended claim language.

30. Applicant with respect to amended claim 258 argued that the prior art fails to disclose the amended claim.

As to applicant's argument in light of the current amendments to claim 258 examiner has revised the rejection and cited pertinent portions for the previously applied prior art that anticipate the newly amended claim language.

31. Applicant argued that depended claims 184, and 332-334 are allowable for the same reasons their independent claim is allowable.

As to applicant's argument dependent claims 184 and 332-334 are not allowable by virtue of their dependence on the independent claim. Please see rejection above.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASGHAR BILGRAMI whose telephone number is (571)272-3907. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia L.M. Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. B./

Examiner, Art Unit 2443

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2443